



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,487	01/07/2002	Spiros Fotinos	224.0509-US	3570

20311 7590 04/10/2007

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/036,487	Applicant(s) FOTINOS ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of IDS, request for extension of time, request for continued examination under 37 CFR 1.114, amendment and remarks, all filed 12/15/06. Claims 24-45 are canceled and new claims 46-69 are added. Thus, new claims 46-69 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/06 has been entered.

Previous rejections that are not reiterated herein are withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 46-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not

Art Unit: 1618

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection.

The original specification as filed does not support a range of 78 to 86% wt% for polyvinylpyrrolidone in claim 46.

The original specification does not provide support for a range of 0.9 to 5.5 wt% for polyethylene glycol in claim 46.

It is noted that the Tables 1 and 2 support specific percent amounts for the polyvinylpyrrolidone and polyethylene glycol and not ranges. For the above ranges to be valid, all points within the range should have been disclosed or the claimed ranges should have been describe. In this case none of this has happened, rather specific points have been described.

Applicant may overcome this rejection by using a Markush language to select the amount of the PVP from the group consisting of 88.3 wt%, 86.6 wt%, 80.0 wt%, 81.3 wt%, and 78.0 wt%. It can then be seen that the rest of the claims will then fall in line, but making that the appropriate combinations are claimed.

For claim 64, there is no support in the original specification for a range of 0.1 to 5 wt% for the active substance. There is support at paragraphs [0005] and [0019] for a range of 0.1 to 15 wt%.

The specific compositions claimed in claims 47-54 are not supported by the specification as filed. For example, see examples 5 (Table 1) and example 8 (Table 2), where the PVP is 80%, PEG is 5.5, silica is 3%, but no lactic acid in either composition while the claimed composition of claim 47 has 4.0 wt% lactic acid. Similar issues are found for the claims 48-54.

Art Unit: 1618

Applicant may overcome the rejection by, for claim 47 for example, either deleting the lactic acid or replacing lactic acid with salicylic acid, which is at 4.0 wt% in example 8 of Table 2.

4. Claims 48-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 48 does not further limit claim 47. Claim 48 is a distinct composition from claim 47. Glycerin, butylenes glycol and polyurethane are not present in claims 46 and 47 and therefore in this case, claim 48 may further comprise these components if the claim is to depend from claim 47 or 46. The same issues are found in claims 49-54.

Claims 48 and 53 contain the trademark/trade names LAPONITE XL and AVALURE UR 410. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe silica and polyurethane and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 46 and 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biederman et al. (US 5,980,921).

Biederman discloses topical composition comprising effective amount of active agent in a more preferred amount of about 0.1% to about 10% and cosmetically acceptable topical carrier such as propylene glycol and polyethylene glycol (column 2, lines 42-46; column 3, lines 19-21; column 4, lines 38-43; column 5, lines 4-16). The composition of Biederman is formulated as a cleansing composition in the form of bath gels, liquid, shampoos, hair tonic, pastes and mousses; the composition comprises surfactants such as sodium lauryl sulfate in a preferred amount of from about 5% to about 10% (column 6, lines 17-28 and 39-46); the composition comprises film

Art Unit: 1618

forming polymer that is not tacky (column 8, lines 56-67). Polyvinylpyrrolidone, one of the preferred polymers is present in amounts of 0.5 wt% to 10 wt% (column 9, lines 37, 43); wherein the composition further comprises plasticizers such as glycols and glycerol in amounts of about 0.5% to 30% (column 10, lines 12-38). It is specifically disclosed that the preferred polymer and the plasticizing solvent (plasticizer) are chosen such that the polymer and the plasticizing solvent are in the aqueous phase of the emulsion which reduces tacky sensation of the polymer on the users hands during application (column 10, lines 39-46). Niacinamide, pyridoxine, panthenol, pantothenic and mixtures thereof are the primary actives (column 4, lines 21-28). In addition to the primary actives, the composition of Biederman optionally contains other active agents namely: anti-inflammatory agents, retinoids, antimicrobial agents, antiandrogens, sunscreens, sunblocks, anti-oxidants/radical scavengers, chelators, hydroxyl acid anti acne agents such as salicylic acid and lactic acid, desquamation agents, depilation agents and skin lightening agents (columns 11-16). Polyvinylpyrrolidone meets the limitation of claims 46. Antimicrobials meet the limitations of claims 56-59. Lauryl sulfate meets the limitation of claim 55. Propylene glycol and lauryl sulfate meet the limitation of permeation enhancer. As a cleansing product, the composition of Biederman meets the claims 46 and 55-69. The comprising language of the claims is open and does not exclude other components present in the composition of Biederman.

Biederman is discussed above and discloses the film forming composition of the claimed invention. Biederman does not disclose a single layer device. Regarding the percent amounts of the components, there is no demonstration that these amounts in combination provides unexpected results to the compositions when a range is claimed indicating variable amounts that

Art Unit: 1618

can be optimized for the desired use. The cleansing formulation is applied to the skin and the application may be in a single layer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the composition of Biederman to the skin as a cleansing composition. One having ordinary skill in the art would have been motivated to apply the composition to the skin in a single layer with the expectation of uniform/efficient cleaning.

Response to Arguments

8. Applicant's arguments filed 12/15/06 have been fully considered but they are not persuasive.

A. Applicant indicates that Examples 1-8 support claims 47-54.

Response:

For A, examples 1-8 do not provide support for the specific claims as described above under 35 USC 112, first.

B. Applicant argues that the claimed invention is not obvious over Biederman because the toilet bar does not fall within the scope of a film and that the cancellation of claim 35 overcomes the art.

Response:

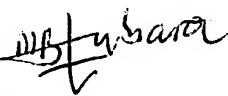
For B, it is noted that a film layer reads on the surface layer of a toilet bar.

Art Unit: 1618

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara 
Patent Examiner
Tech. Center 1600